

## **REMARKS / ARGUMENTS**

### **I. General Remarks**

Please consider the application in view of the following remarks.

### **II. Disposition of Claims**

Claims 1-17, 19-21, and 23-40 are pending in this application. Claims 18 and 22 have been cancelled herein.

Claims 1, 2, 5-14, 16, 17, 19-21, 25-34, and 36-40 have been amended in this Response to more clearly claim the present invention. These amendments add no new matter to the application, and are supported by the specification as filed.

Claims 1, 3, 21, and 23 stand rejected under 35 U.S.C. § 102(b). Claims 2, 4-20, 22, 24-28, and 31-40 stand rejected under 35 U.S.C. § 103(a).

### **III. Rejections of Claims Under § 102(b)**

Claims 1, 3, 21, and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,547,023 to McDaniel *et al.* ("*McDaniel*"). With respect to this rejection, the Examiner writes:

[*McDaniel*] teaches in column 2, lines 14-44 a method of increasing production from a zone along a well bore by controlling the migration of formation sand in a well bore and increasing surface area for well production comprising the steps of: (a) hydrojetting at least one slot into a zone along a well bore; and (b) placing a consolidation material comprising particulates into the slot. Additionally, [*McDaniel*] teaches the use of a resin as the consolidation material.

(Office Action at ¶ 3.) Applicants respectfully disagree.

In order to form a basis for a rejection under 35 U.S.C. § 102(b), a prior art reference must disclose each and every element as set forth in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2131 (2004). *McDaniel* does not teach or suggest a method that includes placing an expandable screen in a well bore and expanding the expandable screen in the well bore, as recited by claims 1 and 21. Applicant therefore respectfully asserts that *McDaniel* does not disclose all elements of claims 1 and 21, and thus these claims are allowable over *McDaniel*. Moreover, since "a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers," and since claims 3 and 23 depend, directly or indirectly, from claim 1 or 21, these dependent claims are allowable for at least the

same reasons. *See* 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicant respectfully requests the withdrawal of these rejections.

IV. Rejections of Claims Under § 103(a)

A. Rejections of Claims Under § 103(a) Over *McDaniel* in View of *Echols*

Claims 2, 17, 19, 20, and 37-40 stand rejected under 35 U.S.C. § 103(a) as being anticipated by *McDaniel* in view of U.S. Patent Application Publication No. 2002/0104217A1 by Echols *et al.* ("*Echols*"). With respect to this rejection, the Examiner writes:

[*McDaniel*] teaches the features claimed except for placing and expanding an expandable screen in the isolated zone of a cased or uncased well bore. [*McDaniel*] also fails to teach an expandable screen where the size of the openings are smaller than both the average size of particulate used and the average size of the formation sands. [*Echols*] teaches in column 2, lines 10-20, column 3, lines 38-42, and column 5, lines 9-22 a method of placing and expanding an expandable screen in the isolated zone of a cased or uncased well bore, wherein the size of the openings in the expandable screen are smaller than both the average size of particulate used and the average size of the formation sands. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified [*McDaniel*'s] method by placing and expanding an expandable screen in the isolated zone of a cased or uncased well bore, wherein the size of the openings in the expandable screen are smaller than both the average size of particulate used and the average size of the formation sands.

(Office Action at ¶ 5.) Applicant respectfully disagrees. To form a basis for a § 103(a) rejection, a combination of prior art references must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2142 (2004). Applicant respectfully asserts that the combination of *McDaniel* and *Echols* cannot obviate these claims because that combination does not teach all elements of the claims.

1. Rejection of Claims 2, 17, 19, 20, and 38

With respect to claims 2, 17, 19, 20, and 38, Applicant respectfully asserts that neither *McDaniel* nor *Echols* teaches the limitation that the size of at least one of the openings in the expandable screen is smaller than the average size of the proppant particulates, as recited in claims 1 and 38, as amended herein. In the Office Action (cited above), the Examiner acknowledges that *McDaniel* does not teach this limitation. *Echols* only teaches using an expandable screen "in preventing formation sand from being produced" and "preventing the

formation or zones from collapsing into the wellbore, etc.” (*Echols* at ¶ 0025 (emphasis added).) Therefore, *Echols* does not teach or suggest that the openings in the expandable screen should be smaller than the average size of the proppant particulates, for example, so as to prevent the migration of proppant particulates into the well bore, as recited in amended claims 1 and 38. Because the combination of *McDaniel* and *Echols* does not teach this element of claims 1 and 38, the combination cannot obviate claims 1 and 38. Since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 2, 17, 19, and 20 depend, directly or indirectly, from claim 1, these dependent claims are allowable for at least the same reasons. See 35 U.S.C. § 112 ¶ 4 (2004). Accordingly, Applicant respectfully requests the withdrawal of these rejections.

2. Rejection of Claims 37-40

With respect to claims 37-40, Applicant respectfully asserts that neither *McDaniel* nor *Echols* teaches the limitation of allowing the expandable screen to prevent the migration of at least one proppant particulate into the well bore, as recited in claim 21, as amended herein. As discussed above, *Echols* teaches the use of an expandable screen in preventing formation sand from being produced or preventing the formation from collapsing into the wellbore, but does not suggest using the expandable screen to prevent the migration of proppant particulates. Because the combination of *McDaniel* and *Echols* does not teach this element of claim 21, the combination cannot obviate claim 21. Since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 37-40 depend, directly or indirectly, from claim 21, these dependent claims include the limitations of claim 21, that neither *McDaniel* nor *Echols* teaches or suggests. See 35 U.S.C. § 112 ¶ 4 (2004). Therefore, Applicant respectfully asserts that claims 37-40 are allowable over the combination of *McDaniel* and *Echols*, and respectfully requests the withdrawal of these rejections.

B. Rejections of Claims Under § 103(a) Over *McDaniel* in View of *Murphey*

Claims 4-8, 11, 13-16, 24-28, 31, and 33-36 stand rejected under 35 U.S.C. § 103(a) as being anticipated by *McDaniel* in view of U.S. Patent No. 4,665,988 by *Murphey et al.* (“*Murphey*”). Applicant respectfully disagrees. To form a basis for a § 103(a) rejection, a combination of prior art references must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2142 (2004). As discussed in Section III. above, *McDaniel*

does not teach or suggest a method that includes placing an expandable screen in a well bore and expanding the expandable screen in the well bore, as recited in claims 1 and 21, as amended herein. Nor does *Murphey* teach or suggest these limitations, as *Murphey* merely teaches the preparation and use of certain types of resin coated fill material for use in subterranean formations. (*See Murphey* at col. 1, ll. 53-57.)

Moreover, with respect to claims 15, 16, 35, and 36, neither *McDaniel* nor *Murphey* teaches or suggests the use of a tackifying material, as recited in these claims. The Examiner writes that “[*Murphey*] teaches polysaccharide as a tackifying material.” (Office Action at ¶ 6.) However, Applicant respectfully submit that *Murphey* only discloses the use of a polysaccharide as a “viscosifying agent” for the fluids used therein, and not as a tackifying material to be used as a consolidation material, as recited in claims 15, 16, 35, and 36. (*See Murphey* at col. 2, ll. 39-51.)

Because the combination of *McDaniel* and *Murphey* does not teach these elements of claims 1 and 21, the combination cannot obviate claims 1 and 21. Since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 4-8, 11, 13-16, 24-28, 31, and 33-36 depend, directly or indirectly, from claim 1 or 21, these dependent claims include the limitations of claims 1 and 21, that neither *McDaniel* nor *Murphey* teaches or suggests. *See* 35 U.S.C. § 112 ¶ 4 (2004). Therefore, Applicant respectfully asserts that claims 4-8, 11, 13-16, 24-28, 31, and 33-36 are allowable over the combination of *McDaniel* and *Murphey*, and respectfully requests the withdrawal of these rejections.

C. Rejections of Claims Under § 103(a) Over *McDaniel* in View of *Murphey* and *Acock*

Claims 9, 10, 12, 19, 20, and 32 stand rejected under 35 U.S.C. § 103(a) as being anticipated by *McDaniel* in view of *Murphey* and U.S. Patent No. 6,732,800 to *Acock et al.* (“*Acock*”). Applicant respectfully traverses. To form a basis for a § 103(a) rejection, a combination of prior art references must teach or suggest each element in the claim. MANUAL OF PATENT EXAMINING PROCEDURE § 2142 (2004). As discussed in Sections III. and IV.B. above, neither *McDaniel* nor *Murphey* teaches or suggests a method that includes placing an expandable screen in a well bore and expanding the expandable screen in the well bore, as recited in claims 1 and 21, as amended herein. Nor does *Acock* teach or suggest these limitations, as *Acock* only teaches certain consolidating and fracturing treatments in subterranean formations generally, but

does not discuss the use of an expandable screen. (*See Acock* at col. 2, ll. 52-60.) Because the combination of *McDaniel*, *Murphey*, and *Acock* does not teach these elements of claims 1 and 21, the combination cannot obviate claims 1 and 21. Since “a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers,” and since claims 9, 10, 12, 19, 20, and 32 depend, directly or indirectly, from claim 1 or 21, these dependent claims include the limitations of claims 1 and 21, that neither *McDaniel* nor *Murphey* nor *Acock* teaches or suggests. *See* 35 U.S.C. § 112 ¶ 4 (2004). Therefore, Applicant respectfully asserts that claims 9, 10, 12, 19, 20, and 32 are allowable over the combination of *McDaniel* and *Murphey*, and respectfully requests the withdrawal of these rejections.

**SUMMARY**

In light of the above remarks, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections. Applicant further submits that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicant believes that there are no fees due in association with this filing of this Response. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicant respectfully requests that the Commissioner accept this as a Petition Therefor, and directs that any additional fees be charged to the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Kent", written over a horizontal line.

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